

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DONALD J. FIECHTER  
and REAL CLOUTIER

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Appeal No. 2003-0097  
Application 09/360,969

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ON BRIEF

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Before ABRAMS, MCQUADE, and NASE, Administrative Patent Judges.  
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Donald J. Fiechter et al. appeal from the final rejection of claims 1 through 20, all of the claims pending in the application.

THE INVENTION

The invention relates to "an interactive electronic game system and more particularly to an interactive electronic bingo game system wherein the system manages the game between two (2) or more players" (specification, page 1). Representative claim 1 reads as follows:

1. An interactive electronic game system comprising:  
a. two or more gaming machines each having display means for displaying images thereon and interaction means for an individual player to interact with the game system,  
b. a central server unit comprising game system control means and communication control means for controlling communications between said central server unit and said gaming machines,  
c. a network connecting said gaming machines to said central server unit,  
d. a random number generating means connected to said central server unit, the central server unit being arranged to play a game in which two or more players select one or more sub-sets of indicia from a set of indicia,  
said selected sub-set being displayed on the display means of a each player's respective gaming machine, said random number generating means generating a sequence of random indicia selected from said set of indicia, said central server unit displaying in turn each of said randomly generated indicia on the display means of each said gaming machines,  
wherein when a randomly generated indicia displayed on said display means matches an indicia selected by said player, said player interactively acknowledges said match through the use of said interaction means,  
and wherein a prize is awarded to the player who first interactively acknowledges the required number of matches.

#### THE REJECTIONS

Claim 17 stands rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the enablement requirement.

Claims 1, 2, 7, 10, 11, 13, 14, 16 through 18 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,830,069 to Soltesz et al. (Soltesz).

Claims 3 through 6, 8, 9, 12, 13, 15 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Soltesz.

Attention is directed to the appellants' brief (Paper No. 15) and to the final rejection and examiner's answer (Paper Nos. 8 and 16) for the respective positions of the appellants and examiner regarding the merits of these rejections.<sup>1</sup>

#### DISCUSSION

##### I. The 35 U.S.C. § 112, first paragraph (enablement), rejection

Insofar as the enablement requirement of § 112, ¶ 1, is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

Dependent claim 17 further defines the interactive game system recited in parent independent claim 14 as comprising game terminals which "permit the players to wager on a sub-set of indicia in anticipation of the wagered sub-set being the first to

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<sup>1</sup> The record indicates that the failure of the examiner to restate the 35 U.S.C. § 112, first paragraph, rejection in the answer was inadvertent.

match the generated individual indicia." The examiner considers the appellants' disclosure to be non-enabling with respect to this subject matter because

[a]lthough the gaming system disclosed by the appellants is capable of allowing players wag[er]ing or betting on a sub-set of indicia in a game, . . . it does not provide means or function that would allow or permit players to wager on a sub-set of indicia in anticipation of the wagered sub-set being the first to match the generated individual indicia. . . . [I]f a player can wager on a subset of indicia in anticipation of the wagered sub-set being the first to match the generated individual indicia, as claimed, that player would always be a winner and can win every game as a result of anticipation of the wagered sub-set [answer, page 4].

This position rests on the nonsensical notion that the "in anticipation . . ." language in claim 17 equates the anticipated winning sub-set of indicia to the actual winning sub-set of indicia, even though the latter has yet to be randomly determined at the time the former is wagered on. Most wagers are made "in anticipation" that they will be winning ones, but with the realization that this anticipation may not be fulfilled. There is nothing in claim 17, or in the underlying disclosure, which is inconsistent with this common sense understanding.

Hence, the examiner has not met the initial burden of advancing acceptable reasoning inconsistent with enablement.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of claim 17.

II. The 35 U.S.C. § 102(e) rejection

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Soltesz discloses a multi-site gaming system and method for playing games of chance such as bingo. In general, the system comprises a central control site 10, a plurality of remote participation sites and a wide area network (WAN) 3 linking the central and participation sites. The central control site includes a PC computer 1, a display screen 11, an automated bingo machine 16 and a video system 18, and each participation site comprises a PC computer 5 and a display screen 12. As described by Soltesz,

[p]rior to the event all participants log onto the system at least an hour prior to the game. Bingo cards for the night are sold and the cash totals from each participation site are sent to the central control at the central site by the WAN 3. Alternatively, totals can be called in by a telephone land line to the central site from the participation sites. A pregame screen drawing is attached to show a typical pre-bingo event on the computers 1 and 5 connected to the WAN 3. The screen shows the date, the time remaining until the

drawing begins, emergency phone numbers and current status of the jackpot for the game. Five minutes before the game starts, card purchases are cut off and the final total of sales are communicated to the central site PC 1, from the participation site PC 5. Any totals received are counted in the jackpot draw.

A totally automated bingo machine 16 is used at the central [PC 1] to randomly select the bingo balls on which the bingo numbers are inscribed. Each bingo ball is randomly selected by the bingo ball selection machine 16 and the drawing of each ball is captured on video at the central site PC 1 by a video system 18 and transmitted through the WAN 3 to each participation site PC 5. . . . The picture at the participation site PC 1 is redrawn at each of the site computers 5 and projected as a video picture on a screen 12 at the participation site.

. . .  
When a bingo is announced by a player in any participation site, the location with the player achieving a bingo has the option to press a bingo virtual button on the screen of the site computer 5 connected to the WAN 3 at the site, or directly calling on a land line to the central site PC 1. Verification of the bingo is done at the central site while the game is stopped. Verification of the bingo is done by calling the central control by a land line and communicating the serial number of the bingo card, or by entering the serial number of the card in the central site computer 1 on the WAN 3 at the central site [column 3, line 25, through column 4, line 4].

Notwithstanding the examiner's finding to the contrary, Soltesz does not meet the limitation in independent claim 1 requiring the selected sub-set to be displayed on the display means of each player's respective gaming machine, the corresponding limitation in independent claim 14 requiring a

plurality of game terminals having a display that allows the players to choose a sub-set of indicia from a set of indicia and display the sub-set of indicia, or the corresponding limitations in independent claim 18 requiring the steps of allowing selection of a sub-set of indicia from a set of indicia on one of the player terminals and displaying a player selected sub-set of indicia on one of the player terminals. The examiner's position that "these limitations are inherent from Soltesz et al.'s system wherein bingo cards record being kept electronically in the system" (answer, page 6) is nothing more than idle conjecture having no factual support in the fair teachings of the reference.

Thus, Soltesz does not disclose, expressly or under principles of inherency, each and every element of the invention set forth in independent claims 1, 14 and 18. Accordingly, we shall not sustain the standing 35 U.S.C. § 102(e) rejection of claims 1, 14 and 18, and dependent claims 2, 7, 10, 11, 13, 16, 17 and 20, as being anticipated by Soltesz.

### III. The 35 U.S.C. § 103(a) rejection

In addition to not teaching subject matter meeting the foregoing limitations in independent claims 1, 14 and 18, Soltesz would not have suggested same to one of ordinary skill in the art. Therefore, we shall not sustain the standing 35 U.S.C.

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§ 103(a) rejection of dependent claims 3 through 6, 8, 9, 12, 13, 15 and 19 as being unpatentable over Soltesz.

SUMMARY

The decision of the examiner to reject claims 1 through 20 is reversed.

REVERSED

NEAL E. ABRAMS	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
	)	
	)	APPEALS AND
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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